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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/028,132      | 12/20/2001  | Stuart T. Gordon     | 82142SMR            | 2406             |

7590

12/19/2002

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 12/19/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |               |  |
|------------------------------|-----------------|---------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |  |
|                              | 10/028,132      | GORDON ET AL. |  |
|                              | Examiner        | Art Unit      |  |
|                              | Hoa V. Le       | 1752          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 01 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____                                    |

This application is before the examiner for consideration.

I. There are two independent groups of claims (1-13 and 22) and (14-21 and 23). They are not considered to be patentably different or distinct. Therefore, no restriction between them is made. Should applicants urge or show otherwise in the next response to this Office action in order for it to be considered timely, a restriction will be made as urged or shown.

II. The first independent claim 1 is considered as the main invention. Claims 2-23 are considered as the secondary embodiments. If claim 1 is found to be allowable, claims 2-23 will let be rejoined with the allowable claim 1. If the first independent group of claims (1-13 and 22) is found to be allowable, the second independent group of claims (14-21 and 23) is let to be rejoined with the first allowable independent group of claims (1-13 and 22).

III. There are two many possible searches for the claimed materials and processes. Therefore, the following species election requirement is made for an initiation of a search.

A. Claims 1-13 and 22 are generic to a plurality of disclosed patentably distinct species comprising (1) many possible species electron transfer agent release compounds with some of them being identified as compounds E(1-12, 15 and 17) on pages 15-21, (2) compound E being at any concentration, (3) compound E being at about 6 to 500 micromol/m<sup>2</sup>, (4) any dye forming unit being close to a support, (5) red dye forming unit being close to the support, (6) compound E being in at any light sensitive layer, (7) compound E in a least light sensitive layer of the dye forming unit, (8) less than 120 sec color development, (9) less than 100 sec color development, (10) less than 60 sec color development, (11) no development inhibitor, (12) development

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inhibitor being in a dye forming unit closest to the support.. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. If applicants election item "(1)" above, applicants are required to elect one compound E but not the general formula for all compound Es.

B. This is a provisional species election requirement, if applicants (1) urge or show and elect the second dependent group of claims (14-21 and 23) for a separate examination.

There are two many possible searches for the claimed materials and processes. Therefore, the following species election requirement is made for an initiation of a search.

Claims 14-21 and 23 are generic to a plurality of disclosed patentably distinct species comprising (1) many possible species electron transfer agent release compounds with some of them being identified as compounds E(1-12, 15 and 17) on pages 15-21, (2) any dye forming unit being close to a support, (3) red dye forming unit being close to the support, (4) compound E being in at any light sensitive layer, (5) compound E in a least light sensitive layer of the dye forming unit, (6) less than 100 sec color development, (7) less than 60 sec color development, (8) no development inhibitor, (9) development inhibitor being in a dye forming unit closest to the support. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. If applicants election item "(1)" above, applicants are required to elect one compound E but not the general formula for all compound Es.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

IV. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

V. No other issue is now considered unit a proper election is made and resolved.

VI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7172 for regular communications and 703-746-7172 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL.  
December 17, 2002

HOA VAN LE  
PRIMARY EXAMINER

*Hoa Van Le*